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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/527,681	03/11/2005	Mario Scholz	39509-213285	9162
26694	7590	10/03/2007		
VENABLE LLP P.O. BOX 34385 WASHINGTON, DC 20043-9998			EXAMINER LOEWE, ROBERT S	
			ART UNIT 1709	PAPER NUMBER
			MAIL DATE 10/03/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/527,681

Applicant(s)

SCHOLZ ET AL.

Examiner

Robert Loewe

Art Unit

1709

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/4/07.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 3/11/05 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

The amendment filed on September 4, 2007 has been received.

Drawings

The drawings are objected to under 37 CFR 1.84: The drawings (Figures 1 through 5) need to be supplied in English. Applicants have stated that complying drawings will be submitted upon an indication of allowable subject matter.

Claim Objections

Claims 4-7 are objected to because of the misspelling of composition. Appropriate correction is required.

Claim 5 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Instant claim 1 already contains the limitation "wherein the doping substance is potassium" from instant claim 5.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 1709

Claim 1 and 5-7 are rejected under 35 U.S.C. 102(b) as being unpatentable over Mangold et al. (US Pat. 6,328,944).

Claim 1: Mangold et al. teaches doped, pyrogenically prepared oxides of metals and/or non-metals which are doped with one or more doping components. Mangold et al. further teaches pyrogenically prepared oxides of metals and/or non-metal can be used as fillers and additives in the silicone and rubber industry (3:26-36). Mangold et al. further teaches potassium salts may be used as dopant (2:57-58) and that the doping salts are introduced by means of aerosol (2:5-45). Mangold further teaches doping levels of 0.00001 to 20 wt% (1:35) and BET surface areas of the doped oxides between 5 and 600 m²/g (1:39-40). See MPEP 2131.03 (anticipation of ranges). Mangold et al. does not specifically teach DBP absorption of the fumed oxide being undetectable or being less than 85% of the normal value for that of fumed silica. However, Mangold et al. anticipates all of the claim limitations of instant claim 1 because the fumed silica taught by Mangold et al. is prepared in the same way as the instant application. Thus, it is expected/anticipated that the materials prepared according to Mangold et al. would inherently have the same properties, in this case, DBP absorption, as the instant application.

Claim 5: Mangold et al. teaches a potassium dopant (2:57-58 and example 5).

Claim 6: Mangold et al. teaches that the doping amount is preferably in the range of 1 to 10,000 ppm (1:35-36).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 1709

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mangold et al. as applied to claim 1 above, and further in view of Azechi et al. (US Pat. 6,331,588).

Mangold et al. teaches doped, pyrogenically-prepared oxides of metals and/or non-metals which are doped with one or more doping components which are useful in silicone rubber compositions as fillers as described in instant claim 1 above.

Mangold et al. does not teach that the silicone rubber is of LSR-type. However, Azechi et al. teaches liquid silicone rubber (LSR) compositions having fumed silica fillers with BET surface areas of from 50 to 600 m²/g (abstract and 4:55-61). Mangold et al. and Azechi et al. are combinable because they are from the same field of endeavor, namely, compositions containing pyrogenically prepared oxide. At the time of invention, a person having ordinary skill in the art would have found it obvious to employ the doped, pyrogenically prepared oxides as taught by Mangold et al. as fillers into the liquid silicone rubber compositions as taught by Azechi et al. with and would have been motivated to do so since Azechi et al. teaches that the addition of fumed/pyrogenically prepared silica imparts strength and durability to silicone rubber (1:26-28 and 4:57-61).

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mangold et al. as applied to claim 1 above, and further in view of Itoh et al. (US Pat. 4,755,554).

Art Unit: 1709

Mangold et al. teaches doped, pyrogenically-prepared oxides of metals and/or non-metals which are doped with one or more doping components which are useful in silicone rubber compositions as fillers as described in instant claim 1 above.

Mangold et al. does not teach that the silicone rubber is of HTV-type. However, Itoh et al. teaches high-temperature vulcanizable/heat curable (HTV) silicone rubber compositions which comprise pyrogenically prepared silica as fillers (abstract and 4:31-40). Mangold et al. and Itoh et al. are combinable because they are from the same field of endeavor, namely, compositions containing pyrogenically prepared oxide. At the time of invention, a person having ordinary skill in the art would have found it obvious to employ the doped, pyrogenically prepared oxides as taught by Mangold et al. as fillers into the high-temperature vulcanizable/high-temperature curable silicone rubber compositions as taught by Itoh et al. and would have been motivated to do so since Itoh et al. teaches that the addition of fumed silica/pyrogenically prepared silica improves the mechanical strengths of the cured silicone rubber compositions (4:31-35).

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mangold et al. as applied to claim 1 above.

Mangold et al. teaches doped, pyrogenically-prepared oxides of metals and/or non-metals which are doped with one or more doping components which are useful in silicone rubber compositions as fillers as described in instant claim 1 above.

The Office recognizes that all of the claimed effects and physical properties are not positively stated by Mangold et al. (specifically, that the silicone rubber composition of instant

Art Unit: 1709

claim 1 possesses lower viscosities and flow limits when compared to fumed silicas of equal of similar surface area). Note however, that Mangold et al. teaches all of the claimed ingredients, process steps and process conditions and thus, the claimed effects and physical properties would implicitly be achieved by carrying out the disclosed process. If it is applicants' position that this would not be the case: (1) evidence would need to be presented to support applicants' position; and (2) it would be the examiner's position that the application contains inadequate disclosure in that there is no teaching as to how to obtain the claimed properties and effects by carrying out only these steps.

Response to Arguments

Applicant's arguments regarding claims 1 and 2, filed September 4, 2007 have been fully considered but they are not persuasive. Although, there are no working examples of a silicone product containing the pyrogenically prepared oxides of the instant application, Mangold et al. teaches that the pyrogenically prepared oxides prepared can be used as fillers and additives in the silicone rubber industry (3:26-36). It follows that Mangold et al. anticipates all of the limitations of claims 1 and 2.

Applicant's arguments with respect to claims 3 and 4 have been considered but are moot in view of the new ground(s) of rejection above.

Art Unit: 1709

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Loewe whose telephone number is (571) 270-3298. The examiner can normally be reached on Monday through Friday from 9:30 AM to 7:00 PM EST.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on (571) 272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1709

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RSL

13-September-2007



MARK EASHOO, PH.D.
SUPERVISORY PATENT EXAMINER

01/02/07